REMARKS

In the Office Action mailed January 26, 2005, claims 1-8 and 10 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,623,529 to Lakritz and claim 9 was rejected under 35 U.S.C. § 103(a) as being obvious over Lakritz in view of one skilled in the art.

Applicant has amended claims 1, 4, and 7 as indicated above. Applicant has also amended the specification to include subject matter inherently disclosed at the time of application. No new matter has been added. Applicant has also added new claims 11-15. The patentable subject matter of each of these new claims lies at least in the adaptation of the processor to a request for boot files received from the computer.

Claim 1 was rejected as anticipated by the Lakritz reference. To anticipate a claim, a reference must teach, either expressly or inherently, each and every element of the claim. See MPEP § 2131.01. Amended claim 1 includes the limitations the processor being "localized to the computer"; "the computer interface is adapted to enable communications exclusively between the computer and the processor"; the processor being "adapted to employ the network interface for communications exclusively with the remote file server"; and the processor returning "a file unavailable notice to the computer if the file is not cached on the storage means and not obtainable from the file server." The Lakritz reference does not expressly or inherently disclose any of these limitations.

The Lakritz reference discloses a visitor (translation) module 202 for use in translating web pages into different languages for visitors to those web pages. While the Lakritz reference does not expressly disclose the location of the visitor module, it does imply that the visitor module is localized to the server 203 hosting the web pages being translated. (see, generally, column 1, line 39 – column 2, line 67.) By localizing the visitor module 202 with the web server 203, the web content is translated only once into

a particular language and provided to the various visitors of the web site who require a particular translation. In this manner, the Lakritz reference discloses that the visitor module is able to provide consistent translations to all web page visitors. Further, the Lakritz reference discloses that having the translation module integrated into the end user's web browser, i.e., localized to the computer accessing the web server, is an undesirable feature because "errors occur in the translation and the appropriate content is not consistently displayed to the user." (Column 1, lines 25-32.) For these reasons, the Lakritz reference discloses that the visitor module is localized to the web server and does not disclose the limitation of amended claim 1 that the processor is "localized to the computer".

As just indicated, the Lakritz reference discloses that the visitor module communicates with all individuals who visit the web pages and require a translation of those web pages. This requires the visitor module to communicate with the many different visitors' computers using its "computer interface". The visitor module does not, in fact, communicate exclusively with any single visitor's computer. For this reason, the Lakritz reference does not disclose the limitation that "the computer interface is adapted to enable communications exclusively between the computer and the processor".

Next, the Lakritz reference is completely silent as to how many web servers a single visitor module may communicate with. Where the Lakritz reference is silent as to this functionality of the visitor module, it does not disclose the limitation of amended claim 1 that "the processor is adapted to employ the network interface for communications exclusively with the remote file server".

Finally, the Lakritz reference discloses that the "visitor will never see an error message (i.e., a '404-document not found') because the requested content is not available in the visitor's language." (Column 6, lines 31-34.) In view of this express statement, the Lakritz reference does not disclose the limitation of amended claim 1 that

the processor returns "a file unavailable notice to the computer if the file is not cached on the storage means and not obtainable from the file server."

For the above-stated reasons, the Lakritz reference does not anticipate amended claim 1. Further, where the Lakritz reference does not anticipate amended claim 1, it also does not anticipate claims 2 and 3, each of which ultimately depends from amended claim 1.

The Lakritz reference also does not disclose all the limitations of amended claim 4, which includes the limitations of "the storage device being localized to the computer" ; "the computer interface is adapted to enable communications exclusively between the computer and the storage device"; and "the processor is adapted to employ the network interface for communications exclusively with the remote file server". As stated above, the Lakritz reference does not disclose any of these limitations and therefore does not anticipate amended claim 4. Further, where the Lakritz reference does not anticipate amended claim 4, it also does not anticipate claims 5 and 6, each of which ultimately depends from amended claim 4.

The Lakritz reference also does not disclose all the limitations of amended claim 7, which includes the limitations of the storage device being "localized to the computer" and "the computer interface being adapted to enable communications exclusively between the computer and the storage device". Again, the Lakritz reference does not disclose these limitations and therefore does not anticipate amended claim 7. Further, where the Lakritz reference does not anticipate amended claim 7, it also does not anticipate claims 8 and 9, each of which ultimately depends from amended claim 7.

Claim 10 was rejected as obvious over the Lakritz reference. MPEP § 2143 establishes the following standard for a finding of a *prima facie* case of obviousness:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As is detailed below, the Lakritz reference does not teach or suggest all the limitations of claim 10.

Claim 10 includes the limitation of "providing to the computer, from a storage device, a list identifying a plurality of files which the storage device may retrieve from a file server". The Lakritz reference does not teach or suggest this limitation. Rather, the Lakritz reference teaches that the visitor module 202 intercepts web page requests from the visitor's web browser. (Column 2, lines 3-19.) Based upon the web page requests, the visitor module delivers the web page content to the visitor's web browser. The Lakritz reference does not even imply that the visitor module provides the visitor's web browser with a list of available files. Where the Lakritz reference does not expressly or inherently disclose this functionality for the visitor module, no assumption should be made regarding this functionality as disclosed in the Lakritz reference. This is especially true when the common form of operation between a web server and a web browser has the web server, not the visitor module, providing a list of available files to the web browser. The Lakritz reference thus does not teach of suggest this limitation.

Claim 10 further includes the limitation of "receiving at the storage device notice from the file server that an updated version of the first file exists on the file server, whereupon the cached copy of the first file is deleted." While Applicant accepts that there are many well-known techniques available for preserving cache space, deleting a cached file upon receiving notice that an updated version is available from a server is not among those cited in the rejection of claim 10 as one that is well-known to those of skill in the art. The two well-known techniques cited in the Office Action for preserving cache space are "by deleting outdated or least recent usage content from storage in

order to make way for newly and higher demand content". Neither of these well-known techniques, however, teach or suggest the limitation of claim 10. As such, the Lakritz reference is insufficient to establish a *prima facie* case of obviousness over claim 10. In the event that the rejection to claim 10 is maintained, Applicant hereby requests that documentary evidence be provided with the next Official Action in accordance with 37 C.F.R. § 1.104(c)(2) and MPEP 2144.03(C).

For the reasons stated above, Applicant hereby requests reconsideration of the rejected claims.

Respectfully submitted,

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